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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/648,325	08/25/2000	Andrew John Holmes	TS7564 (US)	6381

23632 7590 11/15/2005

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EXAMINER
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MCAVOY, ELLEN M

ART UNIT	PAPER NUMBER
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1764

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/648,325

**Applicant(s)**

HOLMES ET AL.

**Examiner**

Ellen M. McAvoy

**Art Unit**

1764

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 2 September 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 7-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicants' submission filed on 02 September 2005 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Matthews et al (4,462,918) in view of European Patent Application 0 434 464 A1 and Karn (4,627,928).

Matthews et al ["Matthews"] teach lubricating oil compositions, and in particular a lubricating oil composition which may be used as a hydraulic fluid (column 1, lines 5-7). The composition comprises a major proportion of a lubricating oil and a minor proportion of each of a Group II metal dithiophosphate and a compound of applicants' formula I (column 1, lines 30-48). The combination of the Group II metal dithiophosphate anti-wear additive with compounds of formula I gives improved anti-wear performance (column 1, lines 49-60). Most preferably,

the Group II metal dithiophosphate is a zinc dialkyl dithiophosphate of which the alkyl groups contain 3-20 carbon atoms (column 2, lines 7-14). The combination of additives may suitably be used with other additives (column 2, lines 38-42). While Matthews teach the addition of other additives, Matthews differ from the instant claims in not teaching the addition of a magnesium salicylate.

European Patent Application 0 434 464 A1 (hereafter EPA '464) teach lubricant compositions especially useful as hydraulic fluids containing an amino succinate ester as corrosion inhibitor (abstract). EPA '464 teach that when used in an acidic environment, it can be desirable to incorporate, inter alia, overbased alkylsalicylate (page 3, lines 49-52).

Karn is relied on as teaching overbased magnesium alkylsalicylates as additives for hydraulic fluids (column 17, lines 41-47). Karn teaches that the magnesium salts can be characterized as basic hydroxyl-containing alkylated aromatic carboxylic acid salts having a magnesium content of at least 150% up to 500% of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present. The examiner is of the position that "up to 500%" is indistinguishable from "more than 500%" of the claims. It would also be obvious to add overbased magnesium alkylsalicylate in an amount sufficient to result in greater than 500% magnesium in the compositions.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to add the overbased magnesium alkylsalicylate of Karn to the lubricating composition of Matthews as taught by EPA '464 and because Matthews specifically teach that other additives may be incorporated into the composition of their invention.

***Claim Rejections - 35 USC § 103***

Claims 7-12, 18, 20 and 22-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yagishita et al (6,306,801).

Yagishita et al [“Yagishita”] disclose a lubricating oil composition comprising a base oil, (A) 0.5 to 20% by mass of an acylated succinimide, (B) 0.05 to 0.3% by mass of zinc dithiophosphate, in terms of the phosphorus content, and (C) 0.5 to 4.0% by mass of a metallic detergent, in terms of the sulfated ash content, based on the total mass of the composition. The lubricating oil composition is preferably used as a gasoline engine oil but other types of oils are taught including hydraulic actuation oils. See column 2, lines 3-13. The examiner is of the position that the hydraulic fluid limitation of the compositions and additive packages of the claims is taught and the zinc dithiophosphate limitation of the claims is taught. The method of claims 22-38 is taught when the compositions of Yagishita are used in a hydraulic environment. Applicants’ open-ended claim language “comprising” allows for the addition of other additives to the composition including succinimide component (A). Yagishita allows for the addition of other additives to the compositions including pour point depressants and antifoamers. See column 11, line 58 to column 12, top. The metallic detergent component of Yagishita may be a basic alkaline earth metal salicylate having a total base number of 100 to 450 mgKOH/g. See column 9, lines 7-40. Calcium and/or magnesium salts are taught in column 10, lines 15-21. Applicants’ claimed compositions differ by specifying that the magnesium salicylate have a magnesium content of more than 500% of the stoichiometrically equivalent amount of magnesium. However, most references characterize overbased metal salts in terms of total base

number or TBN. Indeed, applicants teach in the specification on pages 4-5 that the overbased magnesium salicylate can be characterized by their total base number, and that the total base number is preferably at least 300 mgKOH/g and at most 600 mgKOH/g. Applicants teach that another method of characterizing overbased magnesium salicylates is by the magnesium content relative to the stoichiometrically equivalent amount of magnesium based on the amount of total acid present, and that the overbased magnesium salicylates have a magnesium content of more than 500%. Thus, the examiner is of the position that the claimed "magnesium content of more than 500% of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present", is roughly equivalent to 300-600 mgKOH/g. In the Example set forth on page 10, a highly overbased magnesium alkylsalicylate having a TBN of 337 mgKOH/g also has a magnesium content of about 750% of the stoichiometrically equivalent amount of magnesium based on the amount of total acid present. Thus the examiner is of the position that the basic magnesium salicylate detergent component of Yagishita meets the limitations of the claimed magnesium salicylate detergent.

### ***Claim Rejections - 35 USC § 103***

Claims 13-17, 19, 21 and 34-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yagishita et al (6,306,801) in combination with Matthews et al (4,462,918).

Yagishita is relied on as outlined above. The above rejected claims differ from Yagishita by adding 0.001 to 5 % by weight of a dialkylester of an aminosuccinic acid compound having the structure according to formula I set forth in dependent claim 13. However, Matthews et al

["Matthews"] teaches such an aminosuccinic acid ester as an anti-rust agent in hydraulic fluid compositions which are especially effective in combination with a metal dithiophosphate anti-wear additive. See column 1, line 31 to column 2, line 43. Having the prior art references before the inventors at the time the invention was made it would have been obvious to have added the aminosuccinic acid ester compound to the composition of Yagishita if its known imparted property was so desired. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation relied on by the examiner is the teaching in Yagishita allowing for the addition of conventional additives to the compositions including rust preventives and the teaching in Matthews that the combination of additives may suitably be used with other additives.

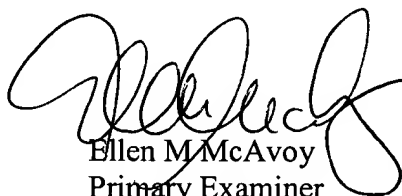
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ellen M. McAvoy whose telephone number is (571) 272-1451. The examiner can normally be reached on M-F (7:30-5:00) with alt. Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on (571) 272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Ellen M. McAvoy  
Primary Examiner  
Art Unit 1764

EMcAvoy  
November 9, 2005